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EXAMINER

GHALI, ISIS A D

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/779,095	Applicant(s) GUERET, JEAN-LOUIS	
	Examiner Isis Ghali	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-30 and 35-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-30 and 35-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/20/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The receipt is acknowledged of applicant's request for extension of time, terminal disclaimer, amendment, and IDS, all filed 12/20/2005.

Claims 2-4, 31-34 have been canceled, and claim 65 has been added.

Claims 1, 5-30, 35-65 are pending and included in the prosecution.

Terminal Disclaimer

1. The terminal disclaimer filed on 12/20/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,723,306 and US Application serial number 10/107,410 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9, 11, 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9 and 11, the expressions "freeze-dried substances", "wetting agents", "healing agents", "vascular protectors" and "skin conditions" do not set forth the metes and bounds of the claims. Recourse to the specification does not define the expressions.

Regarding claim 14, the recitation of "vinyl", which is a chemical group, as an adhesive does not set forth the metes and bounds of the claim. Recourse to the specification disclosed adhesives based on vinyl.

Regarding claim 11, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. The claims are rendered indefinite by raising a question or doubt introduced by a subject of more than one interpretation, and one interpretation would render the claim unpatentable over the prior art. In the present instance, wide ranges are "anti-inflammatory agents" and "keratolytic agents" and the narrow range is "salicylic acid".

Response to Arguments

4. Applicant's arguments filed 12/20/2005 have been fully considered but they are not persuasive. Applicant argues that the terms "freeze-dried substances", "wetting agents", "healing agents", "vascular protectors" and "skin conditions" are common terms known to person of ordinary skill in the art and cannot be indefinite. The examiner is required to provide analysis to why the phrases are indefinite. Applicant further argues

that the recitation of "vinyl" relates to permanent adhesive with vinyl as at least one component, and not necessarily an adhesive having only "vinyl" alone.

In response to the argument regarding "freeze dried substances" recited in claim 9, the examiner position is that "freeze drying" is a known process in the art, however, the claim is directed to moisture absorbing compound chosen from: starch, cellulose, cotton fibers, etc., and it is vague regarding which one of the recited moisture absorbing compounds is freeze dried.

With regard to the phrases "wetting agents", "healing agents", "vascular protectors" and "skin conditions" recited in claim 11, the claim is vague because it recites "wetting agents" as well as other agents that read on wetting agent including glycerin and laponite. The claim recites "healing agent" as well as other agents that can read on healing agent, e.g. anti-inflammatory agents, antibacterial agents, and anti-fungal agents. Claim 11 recites "vascular protectors" as well as vitamin C and vitamin A that read on vascular protectors. The claim further recites "skin conditions", and the examiner believe that applicant meant "skin conditioners", as well as moisturizers that read on skin conditioners. For this reason claim 11 is vague and confusing, e.g. what is the difference between "healing agent" and "anti-inflammatory agents" or between "skin conditioners" and "moisturizers", etc.

With respect to applicant' argument regarding the recitation of "vinyl", stating that "vinyl" relates to permanent adhesive with "vinyl" as at least one component, and not necessarily an adhesive having only "vinyl" alone, the examiner is pointing out to the

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language of claim 14 which has a Markush format "wherein the adhesive matrix comprises permanent adhesive comprising one of vinyl, PVP, PVA, ..." , while "vinyl" is not an adhesive, "vinyl" is chemical group " $-C=C$ " and is not equivalent to the compounds PVP or PVA, or acrylic polymers or polyurethane, etc., in order to be listed in the same Markush group.

Regarding the rejection of claim 11 as being indefinite because it contains a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim), applicants did not argue this rejection, therefore, the examiner maintains her position.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 6-11, 14, 16, 18, 25-30, 39-41, 43, 45-48, 51-59 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,965,276 ('276).

US '276 disclose articles that are made of multiple layers or membranes wherein the article comprises two permeable or semi permeable outer layer, and an intermediate layer (fig. 2; col. 7, lines 18-20, lines 38-52), and construed in a manner that is triggered

to release the agent from inside (col. 9, lines 20-24). The intermediate layer is a reservoir layers for active substances such as abrasives which reads on the depigmenting agents and keratolytic agents, and antiseptic and sterilizing agents which read on healing agents, or cleansing agent (col. 3, lines 48-52). The intermediate layer is sticky and made of adhesive and film forming material that reads on the instant adhesive matrix (col.3, lines 53-55; col.5, lines 3-29); and further the semi permeable layers permit migration of active substances from inside (col.2, lines 50-54). US '276 discloses that the outer layers are formed from polymer or latex materials (col. 4). Further, US '276 discloses that the adhesive inner layer may be made from known adhesive such as polyacrylic polymers and cellulose derivatives (col. 5, line 61 through col. 6, line 9). US '276 further discloses addition of other agents such as powders of calcium carbonate, cornstarch, etc., that read on instant inert compounds and moisture absorbing substances (col. 11, lines 55-68), that further allow for addition of a variety of active agents such as softening agents, cleansing agents, abrasives, etc (col. 12, lines 41-68). The article further comprising impermeable layer and two active agent layers that are different (figure 4). The reference disclosed method of making the article comprising depositing the layers on each other (col.4, lines 26-31).

Response to Arguments

7. Applicant's arguments filed 12/20/2005 have been fully considered but they are not persuasive.

- Applicant argues that Shlenker fails to disclose adhesive matrix between the two non-adhesive layers that contains active agent.

In response to this argument, the examiner is pointing out to Fig. 2; col. 7, lines 18-20, lines 38-52, where Shlenker disclosed article comprises two permeable or semi permeable outer layer, and an intermediate layer comprising adhesive and active agent. The reference further disclosed that the intermediate is an adhesive layer comprising active agent such as abrasives which reads on the depigmenting agents and keratolytic agents, and antiseptic and sterilizing agents which read on healing agents, or cleansing agent (col. 3, lines 48-52).

- Applicant argues that Shlenker failed to disclose the active agent released when the composite structure is wetted by a solvent.

In response to this argument, the examiner is pointing out to the scope of the claims that are directed to article and method of its manufacture, and the future intended use does not impart patentability to claims directed to product or method of making. In any event, the release of active agent upon wetting with solvent depends on the type of active agent. Since the reference disclosed article having the same layers made of the same materials, thus, releasing of the active agent upon wetting with solvent inherent in the article disclosed by the prior art. Moreover, Shlenker disclosed that the article is construed in a manner that is triggered to release the agent from inside (col. 9, lines 20-24) and further disclosed the semi permeable outer layers permit migration of active substances from inside (col.2, lines 50-54), thus, active agent delivered from the intermediate layer is disclosed and the mechanism of its release is inherent for specific agent.

- Applicant argues that Shlenker discloses several reservoirs of material between the layers and not adhesive matrix between the two layers.

In response to this argument, applicant attention is directed to fact that the claims are given the broadest interpretation during examination, and the present claims are directed to article comprising three layer: two outer non-adhesive layers and intermediate mediate layer comprising adhesive and active agent. The reference disclosed the same structure. The claims do not exclude multiple matrices and not directed to one continuous layer.

- Applicant argues that Shlenker teaches surfactant to prevent fusion of layers.

In response to this argument, the examiner is pointing out to col.12, lines 15-25 of the reference, wherein the references disclosed method of making the article comprising the step of treating the first layer with surfactant to prevent its fusion with the second layer, and disclosed the step the of providing intermediate layer between the first and second layers, i.e. the surfactant is used to prevent fusion of the two outer layers in the process of manufacture of the article in order to permit the provision of the intermediate layer. In any events, the claims language does not exclude the presence of surfactant.

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In the light of the foregoing, the examiner believes that all the limitations of claims 1, 6-11, 14, 16, 18, 25-30, 39-41, 43, 45-48, 51-59 and 65 are met by Shlenker's reference.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '276 in view of WO 98/18441 ('441).

The teachings of US '276 are discussed above, however, US '276 does not teach the water as a solvent to deliver the active agent; does not teach the outer layers made of non-woven material that have different properties; does not teach multiple layers having the same active agent; amount of moisture absorbing agents; or using the article for treating hair.

The amounts and the multiplication of layers do not impart patentability to the claims, absent evidence to the contrary.

WO '441 teaches article comprising two layers made of non-woven fabric of different texture and porosity with more than active agents enclosed in between that are released upon wetting with water. The article used for application of active agent to the

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skin and hair (abstract; page 6, second full paragraph; page 8; first full paragraph; page 9, first full paragraph; pages 21 and 22; page 26, second full paragraph; page 27, forth and fifth paragraphs; claims). The article is inexpensive, highly convenient and optimizes the delivery and deposition of the active agents (page 2, third and forth full paragraphs).

Therefore, it would have been obvious to one having ordinary skill in the art the time of the invention to provide the article disclosed by US '276 that comprises two outer layers and one active agent adhesive layer in between and use the non-woven materials disclosed by WO '441 to form the outer layers that have different textures, motivated by the teaching of WO 441 that article with that structure is inexpensive, highly convenient and optimizes the delivery and deposition of the active agents; with reasonable expectation of having an inexpensive convenient article having two outer layers of non woven fabric having different properties and an adhesive intermediate layer containing active agent to be optimally delivered to skin or hair upon wetting with water.

Response to Arguments

10. Applicant's arguments filed 12/20/2005 have been fully considered but they are not persuasive.

Applicants argues that Shlenker in view of Fowler fails to establish a *prima facie* case of obviousness because neither reference, either alone or in combination, discloses or suggests each and every element of the claims. Schlenker fails to disclose

all of the claim elements as recited in independent claims 1 and 56, from which each of the rejected claims depends. Fowler does not correct the deficiencies of Shlenker.

In response to these applicant's argument, Shlenker' reference disclosed all the elements of the generic claims 1 and 56 as discussed above. Applicant failed to point out any deficiency of Fowler, and one cannot show nonobviousness by attacking one reference where the rejections are based on combinations of references. In any event, Fowler is relied upon for the solely teaching of the mechanism of release of the active agent that is enclosed between two non-woven layers and released from an article upon wetting with water. It is well established that the claims are given the broadest interpretation during examination. A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, one having ordinary skill in the art the time of the invention would have been motivated to provide the article disclosed by Shlenker that comprises two outer layers and one active agent adhesive layer in between and use the non-woven materials disclosed by Fowler to form the outer layers that have different textures, motivated by the teaching of Fowler that article with that structure is inexpensive, highly convenient and optimizes the delivery and deposition of the active agents; with reasonable expectation of having an inexpensive convenient article having two outer layers of non woven fabric having different properties and an adhesive intermediate layer containing active agent to be optimally delivered to skin or hair upon wetting with water.

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a) over the combined teaching of the references.

11. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '276 in view of US 6,338,839 ('839).

The teachings of US '276 are discussed above, however, the reference does not teach the inert compound to be polyamide.

US '839 teaches topical cosmetic composition that has transfer resistance from the skin to the surfaces it comes in contact with (abstract; col.2, lines 17-20, 30-35). The composition comprises Orgasol which is polyamide powder (col.5, lines 4, 49-58).

Therefore, it would have been obvious to one having ordinary skill in the art the time of the invention to provide the article disclosed by US '276 that comprises two outer layers and one active agent adhesive layer in between, and add polyamide powder to the active agent containing layer as disclosed by US '839, motivated by the teaching of US '839 that cosmetic comprising this powder has transfer resistance from the skin to the surfaces it comes in contact with, with reasonable expectation of having an article comprising two outer layers and middle adhesive layer that delivers a cosmetic that has transfer resistance on application to skin.

Response to Arguments

12. Applicant's arguments filed 12/20/2005 have been fully considered but they are not persuasive.

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Applicant argues that Shlenker in view Auguste fails to establish a prima facie case of obviousness because neither reference, either alone or in combination, discloses or suggests each and every element of the claims. Schlenker fails to disclose all of the claim elements as recited in independent claim 1, from which claim 44 depends. Auguste does not correct the deficiencies.

In response to these applicant's argument, Shlenker' reference disclosed all the elements of the generic claim 1 as discussed above. Applicant failed to point out any deficiency of Auguste, and one cannot show nonobviousness by attacking one reference where the rejections are based on combinations of references. In any event, Auguste is relied upon for the solely teaching of polyamide. It is well established that the claims are given the broadest interpretation during examination. A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore one having ordinary skill in the art the time of the invention would have been motivated to provide the article disclosed by Shlenker that comprises two outer layers and one active agent adhesive layer in between, and add polyamide powder to the active agent containing layer as disclosed by Auguste, motivated by the teaching of Auguste that cosmetic comprising this powder has transfer resistance from the skin to the surfaces it comes in contact with, with reasonable expectation of having an article comprising two outer layers and middle adhesive layer that delivers a cosmetic that has transfer resistance on application to skin.

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a) over the combined teaching of the references.

13. Claims 12, 13, 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '276 in view of JP 04108710 ('710).

The teachings of US '276 are discussed above, however US '276 does not teach the magnetizable particles.

JP '710 teaches cosmetic in adhesive matrix comprising magnetizable particles that are capable of promoting of blood flow to the skin without causing inflammation to the skin (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art the time of the invention to provide the article disclosed by US '276 that comprises two outer layers and one active agent adhesive layer in between, and add magnetizable particles to the active agent containing layer as disclosed by JP '710, motivated by the teaching of JP '710 that the magnetizable particles are capable of promoting the blood flow to the skin without causing its inflammation, with reasonable expectation of having an article comprising two outer layers and middle adhesive layer comprising magnetizable particles that promotes the blood flow to the skin without causing its inflammation.

Response to Arguments

14. Applicant's arguments filed 12/20/2005 have been fully considered but they are not persuasive.

Applicants argues that Shlenker in view of JP '710 fails to establish a prima facie case of obviousness because neither reference, either alone or in combination, discloses or suggests each and every element of the claims. Shlenker fails to disclose all of the claim elements as recited in independent claims 1 and 61 from which claims 12,13, and 62-64 depend. JP '710 does not correct the deficiencies.

In response to these applicant's argument, Shlenker' reference disclosed all the elements of the generic claims 1 and 61 as discussed above. Applicant failed to point out the deficiency of JP '710, and one cannot show nonobviousness by attacking one reference where the rejections are based on combinations of references. In any event, JP '710 is relied upon for the solely teaching of magnetic particles. It is well established that the claims are given the broadest interpretation during examination. A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, it would have been obvious to one having ordinary skill in the art the time of the invention to provide the article disclosed by Shlenker that comprises two outer layers and one active agent adhesive layer in between, and add magnetizable particles to the active agent containing layer as disclosed by JP '710, motivated by the teaching of JP '710 that the magnetizable particles are capable of

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promoting the blood flow to the skin without causing its inflammation, with reasonable expectation of having an article comprising two outer layers and middle adhesive layer comprising magnetizable particles that promotes the blood flow to the skin without causing its inflammation.

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a) over the combined teaching of the references.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
Art Unit 1615

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Isis Ghali